

REMARKS

Claims 1, 2, 4, 18, 19, 20, 23 and 24 are rejected under 35 USC 112, second paragraph. Applicants request reconsideration and withdrawal of the rejection for the reasons that follow.

Applicants believe that claim 4 is the only claim that utilizes the expression "hydrocarbyl". Applicants do not understand the basis for rejecting any other claim when the objected to expression is found only in claim 4.

Applicants note that the Examiner does not provide any basis for asserting that the rejected claims are indefinite under 35 USC 112, second paragraph, other than the contention that the expression "hydrocarbyl" is being used in a manner that is contrary to its normal meaning. However, the claim contains a precise definition for "hydrocarbyl". Thus, there is no doubt that one of ordinary skill in the art can readily ascertain the metes and bounds of the claims. This is all that is required to conform with the requirements of 35 USC 112, second paragraph.

Applicants position is supported by MPEP 2173(a), which states in part:

2173.05(a) New Terminology

... >TERMS USED CONTRARY TO THEIR ORDINARY MEANING MUST BE CLEARLY REDEFINED IN THE WRITTEN DESCRIPTION

Consistent< with the well-established axiom in patent law that a patentee >or applicant< is free to be his or her own lexicographer, a patentee >or applicant< may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings >if the written description clearly redefines the terms. See, e.g., *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999) ("While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning," in such a situation the written description must clearly redefine a claim term "so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term.");< *Hormone Research Foundation Inc. v. Genentech Inc.*, 904 F.2d 1558, 15 USPQ2d 1039 (Fed. Cir. 1990). Accordingly, when there is more than one definition for a term, it is incumbent upon applicant to make clear which definition is being relied upon to claim the invention. Until the meaning of a term or phrase used in a claim is clear, a rejection under 35 U.S.C. 112, second paragraph is appropriate. It is appropriate to compare the meaning of terms given in technical dictionaries in order to ascertain the accepted meaning of a term in the art. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Applicants assert that MPEP 2173.05(a) is directly on point. In this instance, not only does the written description contain a precise definition of "hydrocarbyl", but the definition is included in the claim.

Applicants further point out that MPEP 2173.01 (On-line edition), which was cited by the Examiner to support the rejection, does not state that: "Terms may not be "used in ways that are contrary to the accepted meanings of the art"" as quoted by the Examiner. Indeed, MPEP 2173.01 is clear that "a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought." This also supports Applicants position that the claims meet the requirements of 35 USC 112, second paragraph. MPEP 2173.01 is reproduced below:

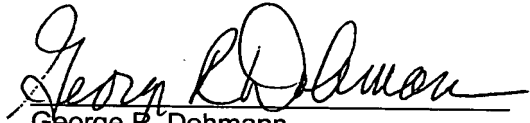
2173.01 Claim Terminology

A fundamental principle contained in **35 U.S.C. 112**, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

For the reasons discussed above, Applicants request reconsideration and withdrawal of the rejection under 35 USC 112, second paragraph, and allowance of all of the claims in pending in this application.

Entry of this response and reconsideration and allowance of the claims is requested.

Respectfully submitted,


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